

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Alfred T. TABAYOYON, JR. et al

Art Unit: 2143

Application No: 09/974,624

Examiner:
Joseph E. Avellino

Filed: October 9, 2001

For: NETWORK-BASED DOCUMENT DELIVERY SYSTEM
WITH RECEIPT AND DISPLAY VERIFICATION

REPLY BRIEF

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Pursuant to MPEP 1208, this Reply Brief is provided as a
substitute Appeal Brief for the Appeal Brief filed May 22, 2006.

Real Party in Interest

Swiftview, Inc.

Related Appeals and Interferences

None

Status of Claims

All claims 1-22 are rejected, no claims are withdrawn.

Status of Amendments

No amendment was filed subsequent to the last office action.

Summary of Claimed Subject Matter

Claims 1, 2, 9, 10, 13 and 14 are representative of the claimed subject matter.

Claim 1

Claim 1, best understood with reference to FIG. 1, recites a method comprises the steps of

"a. generating a document file (print file 37, FIG. 1) describing the document on [a] sender computer" (paragraph 26),

"b. sending the document file from the sender computer to [a] server computer" (paragraph 25)

"c. sending email (42, FIG. 1) to a receiver computer containing a hypertext link that the receiver activates to send a reference to the document file to the server computer" (paragraph 29);

"d. sending the document file from the server computer to the receiver computer after the server computer receives the reference to the document file from the receiver computer" (paragraph 30);

"e. processing the document file sent to the receiver computer to generate a display of an image of the document in a browser window (26, FIG. 1) on the receiver computer" (paragraph 36); and

"f. sending verification data from the receiver computer to the server computer indicating that the receiver computer has successfully displayed the image of the document in the browser window" (paragraph 34).

Claim 2

Claim 2 depends on claim 1 and recites the additional steps of

"g. storing log data on the server computer indicating when the receiver computer returned the verification data to the server computer indicating that the receiver computer has successfully displayed in the browser window the image of the document referenced by the hypertext link (paragraph 44)" ; and

"h. providing the sender computer with access to the log data via the computer network (paragraph 44)."

Claim 9

Claim 9 depends on claim 1 and recites the additional step of
"g. transmitting a publish request from the sender computer to the server computer, wherein the publish request identifies the receiver computer, wherein the publish request indicates that the receiver computer is to be prevented from sending the document file to a printer (paragraph 26)."

Claim 10

Claim 10 depends on claim 9 and recites
"generating on the sender computer a print file for directing a printer to print the document, and then compressing the print file to generate the document file" (paragraph 28, lines 28-33),
"decompressing the document file to produce the print file" (paragraph 38), and
"processing the print file to generate the display of the image of the document in the browser window on the receiver computer" (paragraph 38)

Claim 13

Claim 3 depends on claim 1 and recites the novel additional limitation that "the receiver computer returns the verification data to the server computer as an encoded network address".

Claim 14

Referring to the drawings and specification, the invention as recited in claim 14 is a method for transmitting a document file describing a document from a sender computer to a receiver computer via a computer network linking the sender computer and the receiver computer to a server computer, wherein the sender computer is operated by a sender, wherein the receiver computer is operated by a receiver, wherein the receiver computer includes a monitor viewable by the receiver. The method comprises the steps of:

- a. transmitting the document file via the computer network from the sender computer to the server computer;
- b. storing the document file on the server computer and assigning

the document file a unique network address;

c. transmitting an email message via the computer network to the receiver computer, wherein the email message includes a hypertext link to the document file's assigned network address;

d. displaying the email message on the receiver computer monitor so that the receiver may view it and activate the hypertext link whereby the receiver computer returns the document file's network address to the server computer;

e. transmitting the document file from the server computer to the receiver computer via the computer network following the receiver's activation of the hypertext link; and

f. providing viewer software running on the receiver computer for generating a display on the receiver computer monitor of the document described by the document file when received by the receiver computer;

wherein when the viewer software has successfully displayed the document, it automatically returns verification data in the form of an encoded network address to the server computer via the computer network verifying that the document has been successfully displayed.

Grounds For Rejection To Be Reviewed On Appeal

Grounds for rejection to be reviewed on appeal are:

1. whether claims 1-2, 4-8, 13-17 and 21 should be rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US patent 6,789,105 (McMillan) in view of U.S. patent 6,360,254 (Linden), and U.S. patent 6,266, 703 (Clark),

2. whether claims 9, 10, and 20 should be rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of McMillan, Linden, Clark and US patent 6,209030 (Ohashi), and

3. whether claims 11, 12, 18 and 19 should be rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan, Linden, Clark and U.S. patent 6,237,099 (Kurokawa).

Argument

The comments appearing in the Examiner's Answer dated July 25, 2006 appear to be based on outdated versions of some of the claims as amended in the applicant's Response filed January 27, 2006. The applicant's arguments below nonetheless respond to the Examiner's

arguments to the extent that they are relevant to the claims as they currently exist.

1. Arguments against rejection of claims 1-2, 4-8, 13-17 and 21 under 35 U.S.C. 103(a) as being unpatentable over the combination of McMillan, Linden, and Clark

Claims 1, 4-6, 14-15 and 21

Regardless of whether McMillan and Linden teach steps a-e of claim 1, the applicant stipulates that steps a-e of claim 1 are conventional. It is known to generate a document file and store it on a server, to then send email to a receiver with a hypertext link referencing the document file, and to then send the document file to the receiver when the email recipient activates the hypertext link, so that a browser in the receiver can display the document in a browser window.

What is new is the notion of the receiver sending an acknowledgement back to the server after the receiver has received document in response to activation of a hypertext link contained in email and has successfully displayed the document described by the document file in a browser window. Conventional browsers are not adapted to do that. The applicant teaches at paragraph [30] of the specification to provide the browser with a plug-in that returns such an acknowledgment after the browser has displayed the document.

The Examiner admits that McMillan and Linden do not teach step f of claim 1 but relies on Clark as teaching step f. Clark teaches a receiver computer sends an acknowledgment back to a server computer indicating it has successfully displayed a document, however the receiver does not acquire the document in response to activating a hypertext link conveyed in an email as recited in claim 1.

Clark teaches that the server sends the receiver an email, but the email conveys not a hypertext link, but an attached "isochronous data object" as illustrated in FIG. 2A. That object is a data record including a data field 43 listing one or more "isochronous data transmissions" such as real time video or voice transmissions (which Clark also calls "documents") that the recipient may choose to receive

and display (col. 1, lines 40-43). The data record conveyed in the email also has data fields conveying other information including an identification of the recipient (40), "attributes" of a distribution (41) of which the object is a part, "attributes" of the referenced documents (44), a request for "confirmation of delivery" 42, and data 45 defining timing of the conformation. On receiving the email, the recipient stores the data record it conveys locally and thereafter employs software in the recipient's computer to access and process that data record (step 132, FIG. 5). The software displays the list of available isochronous data transmissions ("documents") referenced by field 43 of the data record and allows a user to select one of those documents (step 138). The software then "queues the object (i.e. the selected document) for viewing" (step 136). Presumably, the software on the receiver does this by requesting the server to begin the isochronous transmission of the selected document, though Clark does not discuss how an object is "queued for viewing". The receiver software then displays the document as it is received, computes the elapsed time the document is displayed (step 146), and thereafter sends an acknowledgement to the sender (step 148) indicating that elapsed time, along with an ID of the document and an ID of the particular distribution of the isochronous data object. Presumably these ID's, along with the network address to which the acknowledgement is to be sent are the "attributes" conveyed in fields 40 and 44 of the isochronous object, though Clark is vague as to the nature of the information these fields holds. The acknowledgement may be sent to the server in the form of a data record, though Clark does not discuss the mechanism for sending the acknowledgment to the server or the form of that acknowledgment.

The question of patentability of claim 1 lies in whether Clark would motivate one of skill in the art to adapt a receiver to send an acknowledgement to a server after having successfully displayed in a browser window a document acquired from the server in response to activation of a hypertext link conveyed in an email as recited in claim 1. Note that the "isochronous data object" conveyed in Clark's email is not a hypertext link as recited in claim, it is a data record. Clark teaches that the receiver acquires the document not by activating a hypertext link in the email but by opening and processing

that data record and acquiring the document from the server in the course of processing that data record.

Clark provides no suggestion that it is possible to use hypertext link activation to initiate a process of not only receiving a document but sending an acknowledgment when it is displayed. While a conventional hypertext link includes a reference to the document to be received, it does not include any indication as to whether the receiver is requested to send an acknowledgment after it displays the document. One would want a receiver to send an acknowledgement back to a server after having successfully displayed a document received from the server only if the server wants such an acknowledgement. That is why the data record sent in Clark's email contains a "confirmation request" field indicating whether an acknowledgement is wanted. How would a receiver know when the server wants the acknowledgment if it obtains the document in response to activating a hypertext link? Also since Clark teaches the acknowledgment should identify the document being acknowledged, how would the receiver obtain the necessary document ID or other information to be included in the acknowledgement it obtains the document in response to activating a hypertext link which does not provide that information? How would the receiver know where to send such an acknowledgment? The applicant's specification teaches how to resolve these problems when the process of document downloading, display and acknowledgment is initiated when the receiver simply activates a hypertext link to the document in an email, but Clark does not teach this. Clark teaches that this information should be sent in the form of an isochronous data record attached to email that the receiver must process to determine this information, and one of skill in the art would be motivated to follow that particular procedure

Clark therefore does not either enable or motivate one of skill in the art to adapt a receiver to send an acknowledgement to a server after having successfully displayed in a browser window a document acquired from the server in response to activation of a hypertext link in an email as recited in claim 1. Claim 1, as well as claims 4-6, 14-15 and 21 are therefore patentable over the combination of McMillan, Clark and Linden.

Claim 2

Claim 2 depends on claim 1 and is patentable over the combination of McMillan, Clark and Lindon for reasons expressed above in connection with claim 1. Claim 2 further recites storing log data on the server indicating when the receiver returned the verification data and providing the sender with access to the log data via the computer network. The Examiner cites McMillan's step FIG. 13, step 410 and col. 9, line 15-52 as teaching this, but none of the cited sections of McMillan relate to a server computer storing log data indicating when the receiver has returned verification data.

Claims 7 and 16

Claims 7 and 16 depend on claim 1 or 14 and are patentable over the combination of McMillan, Clark and Lindon for reasons expressed above in connection with claims 1 and 14. Claims 7 and 16 further recite transmitting a publication request that "indicates the receiver must sign on to the server computer by transmitting a user name and a user password ... in order to receive the document file". Paragraphs 6 and 7 of the Examiner's Reply indicate that McMillan teaches this at col. 7, lines 59-67, however this section of McMillan says nothing about passwords and user names.

Claims 8 and 17

Claims 8 and 17 depend on claim 1 and are patentable over the combination of McMillan, Clark and Lindon for reasons expressed above in connection with claim 1. Claim 8 further recites verifying the receiver is signed on to the server computer before transmitting the document file to the receiver computer. Paragraph 8 of the Examiner's Reply indicates that McMillan teaches this at FIG. 14, 41, col. 9, lines 15-53 and at col. 8, lines 17-48. Co. 9, lines 15-53 discusses a "tracking activation step 410 of FIG. 13 relating to a content server that provides content (e.g., a document) to be incorporated into emails and an email server that sends the emails to recipients. This section of McMillan mentions "User Login access" and "password, but it appears that the login and password relates to the user ("partner") that is creating the content to be sent (col. 6, lines 5-9) and wants to obtain tracking data associated with the sending of

the emails and content. McMillan (col. 3, lines 15-35) teaches that content such as a document is delivered to a recipient as code embedded in an email which executes as soon as the recipient opens the email causing the recipient computer to display the content/document. There is no requirement for the recipient to log in to the server in order to receive the content as recited in claims 8 and 17.

Claim 13

Claim 13 depends on claim 1 and is patentable over the combination of McMillan, Clark and Lindon for similar reasons. Claim 13 further recites "the receiver computer returns the verification data to the server computer as an encoded network address." The Examiner cites McMillan, col. 9, lines 15-52 as teaching this, however nothing in this section of McMillan or in any of the cited references that any verification of any activity by any computer should be transmitted to a sever computer in the form of an encoded network address.

2. Arguments against rejection of claims 9, 10, and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over the combination McMillan, Linden, Clark and Ohashi.

Claims 9, 10 and 20

The Examiner relies on the combination of McMillan, Linden and Clark as teaching the underlying subject matter of the parent claim 1 of claim 9 and relies on Ohashi as teaching the additional subject matter of claim 9. As discussed above in connection with claim 1, McMillan, Linden and Clark fail to teach the subject mater of claim 1.

Claims 9, 10 and 20 further recite that the document file being sent to the recipient is a print file. As described in the applicant's specification (paragraph 24), a print file is a particular kind of file that describes a document in a language understood by a printer. A computer sends a print file to the printer when it wants the printer to print the document. McMillan, Linden, Clark and Ohashi do not discuss a system in which a server sends a print file to a receiver after the receiver activates a hypertext link in an email, or

a receiver system that produces a display of a document in a browser window based on a print file. A conventional HTML browser normally receives and processes HTML files, not print files.

Claims 9, 10 and 20 further recite that the server also receives a publish request identifying the receiver and indicating that the receiver is to be prevented from forwarding the print file it received from the server to a printer. The Examiner refers to col. 4, lines 43-67, col. 5, lines 35-45 and FIG. 4 of Ohashi as teaching to place a tag in an HTML file describing a document to be displayed in a browser window. The tag tells the browser to refrain from permitting a user to either print the document or to perform a print screen operation (col. 4, lines 22-32). In a print screen operation, the receiver creates a print file that describes the display currently on the screen of a display monitor and sends the print file to a printer in a manner that the printer can understand. The printer then prints an image of the screen. In a document print operation, the browser processes the HTML file to create a print file describing the document, and then sends the print file to the printer. Thus the tag in Ohashi's HTML file tells the browser refrain from creating a print file and sending it to a printer. The tag does not tell the browser to refrain from forwarding a print file it received from the server to the printer as recited in claims 9 and 20. Ohashi would not motivate one of skill in the art to provide a tag preventing the browser from forwarding an HTML file received from the server to a printer because an HTML file that would not be understood by a printer.

3. Arguments against rejection of claims 11, 12, 18 and 19 should be rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan, Linden, Clark and Kurokawa.

Claims 11 and 12, 18 and 19

The Examiner relies on McMillan, Linden, and Clark as teaching the subject matter of the parent claims 1 or 14 of claims 11 and 12 or 18 and 19, and relies on Kurokawa only as teaching the additional subject matter of claims 11 and 12. Claims 11 and 12 are patentable over the combination of McMillan, Linden, Clark and Kurokawa since,

as discussed above, McMillan, Linden, and Clark fail to teach the underlying subject matter of claims 1 and 14.

Claims Appendix

1. A method for transmitting a document from a sender computer to a receiver computer via a computer network linking the sender computer and the receiver computer to a server computer, wherein the sender computer is operated by a sender, wherein the receiver computer is operated by a receiver, the method comprising the steps of:

a. generating a document file describing the document on the sender computer;

b. sending the document file from the sender computer to the server computer;

c. sending email to the receiver computer containing a hypertext link that the receiver activates to send a reference to the document file to the server computer;

d. sending the document file from the server computer to the receiver computer after the server computer receives the reference to the document file from the receiver computer;

e. processing the document file sent to the receiver computer to generate a display of an image of the document in a browser window on the receiver computer; and

f. sending verification data from the receiver computer to the server computer indicating that the receiver computer has successfully displayed the image of the document in the browser window.

2. The method in accordance with claim 1 further comprising the steps of:

g. storing log data on the server computer indicating when the receiver computer returned the verification data to the server

computer indicating that the receiver computer has successfully displayed in the browser window the image of the document referenced by the hypertext link; and

h. providing the sender computer with access to the log data via the computer network.

3. The method in accordance with claim 1 further comprising the steps of:

g. transmitting a comment file containing comments generated by the receiver from the receiver computer to the server computer, wherein the comment file references the document file;

h. storing the comment file on the server computer; and

i. providing the sender computer with access to the comment file via the computer network.

4. The method in accordance with claim 1 further comprising the step of:

g. transmitting a publish request from the sender computer to the server computer wherein the publish request identifies the receiver computer.

5. The method in accordance with claim 4 further comprising the step of:

h. storing the document file in the server computer and assigning a network address to the document file stored on the server computer, wherein the hypertext link references the assigned network address.

6. The method in accordance with claim 1 further comprising the step of:

g. sending a document password entry form from the server computer to the receiver computer after the server computer receives the reference to the document file from the receiver computer, wherein the receiver enters into the document password entry form a document password associated with the document that the receiver computer sends to the server computer prior to step d.

7. The method in accordance with claim 6 further comprising the step of:

h. sending a user sign-in form from the server computer to the receiver after the server computer receives the reference to the document file from the receiver computer at step c, wherein the user enters into the sign-in form a user name and a user password that the receiver computer sends to the server computer prior to step d.

8. The method in accordance with claim 1 wherein step a comprises generating on the sender computer a print file for directing a printer to print the document, and processing the print file to generate the document file.

9. The method in accordance with claim 1 wherein the document file is a print file and the method further comprising the step of:

g. transmitting a publish request from the sender computer to the server computer, wherein the publish request identifies the receiver computer, wherein the publish request indicates that the

receiver computer is to be prevented from sending the document file to a printer.

10. The method in accordance with claim 9 wherein step a comprises generating on the sender computer a print file for directing a printer to print the document, and then compressing the print file to generate the document file and

wherein step e comprises decompressing the document file to produce the print file and then processing the print file to generate the display of the image of the document in the browser window on the receiver computer.

11. The method in accordance with claim 1 further comprising the steps of:

g. assigning to the document file a document password generated by the sender, and

h. transmitting the document password to the server computer.

12. The method in accordance with claim 11 further comprising the steps of:

i. providing a document password entry form to the receiver computer in which the receiver enters the document password,

j. conveying the document password entered into the document password entry form to the server computer, and
wherein step g is carried out only after the server computer receives the document password from the receiver computer.

13. The method in accordance with claim 1 wherein the receiver computer returns the verification data to the server computer as an encoded network address.

14. A method for transmitting a document file describing a document from a sender computer to a receiver computer via a computer network linking the sender computer and the receiver computer to a server computer, wherein the sender computer is operated by a sender, wherein the receiver computer is operated by a receiver, wherein the receiver computer includes a monitor viewable by the receiver, the method comprising the steps of:

- a. transmitting the document file via the computer network from the sender computer to the server computer;
- b. storing the document file on the server computer and assigning the document file a unique network address;
- c. transmitting an email message via the computer network to the receiver computer, wherein the email message includes a hypertext link to the document files assigned network address;
- d. displaying the email message on the receiver computer monitor so that the receiver may view it and activate the hypertext link whereby the receiver computer returns the document file's network address to the server computer;
- e. transmitting the document file from the server computer to the receiver computer via the computer network following the receiver's activation of the hypertext link; and
- f. providing viewer software running on the receiver computer for generating a display on the receiver computer monitor of the

document described by the document file when received by the receiver computer;

wherein when the viewer software has successfully displayed the document, it automatically returns verification data in the form of an encoded network address to the server computer via the computer network verifying that the document has been successfully displayed.

15. The method in accordance with claim 14 further comprising the step of:

g. prior to step a, transmitting a publish request from the sender computer to the server computer wherein the publish request identifies the receiver that is to receive the email message at step c.

16. The method in accordance with claim 15 wherein the publish request transmitted in step g indicates that the receiver must sign on to the server computer by transmitting, prior to step e, a user name and a user password to the server computer via the computer network in order to receive the document file at step e.

17. The method in accordance with claim 16 wherein step e comprises the sub-steps of:

e1. verifying that the receiver is signed on to the server computer, and

e2. thereafter transmitting the document file from the server computer to the receiver computer via the computer network following the receiver's activation of the hypertext link.

18. The method in accordance with claim 17 further comprising the steps of:

h. assigning to the document file a document password generated by the sender; and

i. prior to step b, transmitting the document password to the server computer.

19. The method in accordance with claim 18 wherein step e comprises the substeps of:

e1. providing a document password entry form to the receiver computer in which the receiver enters the document password;

e2. conveying the document password entered into the document password entry form from the receiver computer to the server computer; and

e3. transmitting the document file from the server computer to the receiver computer via the computer network at step e only after the server computer receives the document password from the receiver computer.

20. The method in accordance with claim 15 wherein the document file is a print file and wherein the publish request indicates whether the receiver computer is to be prevented from sending the document file to a printer.

21. The method in accordance with claim 14 further comprising the steps of:

g. storing log data on the server computer indicating when the receiver computer returned the verification data to the server computer; and

h. providing the sender computer with access to the log data via the computer network.

22. The method in accordance with claim 14 further comprising the steps of:

g. transmitting a comment file containing comments generated by the receiver from the receiver computer to the server computer, wherein the comment file references the document file;

h. storing the comment file on the server computer; and

i. providing the sender computer with access to the comment file via the computer network.

Evidence Appendix

Not applicable.

Related Proceedings Appendix

Not Applicable.

Respectfully submitted,



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